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| | | | EXAMINER |
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## Technology Center 2100

# BEFORE THE BOARD OF PATENT APPEALS
# AND INTERFERENCES

Application Number: 10/748,870
Filing Date: December 29, 2003
Appellant(s): DEAN ET AL.

John C. Pokotylo
For Appellant

## EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/28/2007 appealing from the Office action

mailed 11/01/2006.

## (1) Real Party of Interest

The real party of interest is Google, Inc. Assignment of the above-referenced

patent application from inventors Jeffrey A. Dean and Krishna Bharat to Google, Inc.

was recorded in the Patent Office starting at Frame 0155 of Reel 016898. Assignment

of the above-referenced patent application from inventor Paul Bucheit to Google, Inc.

was recorded in the Patent Office on August 18, 2007 starting at Frame 0493 of Reel

019719.

## (2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

## (3) Status of Claims

The statement of the status of claims contained in the brief is correct.

## (4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

## (5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

## (6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

## (7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

### (8) Evidence Relied Upon

| 6804659 | Graham et al | 10-2004 |
| 6505169 | Bhagavath et al | 01-2003 |
| 6006225 | Bowman et al | 12-1999 |
| 2004/0093558 | Weaver | 05-2004 |

Cook, Miles "First Drive: 2002 Subaru Impreza WRX, Edmunds.com, Jan 22, 2001,

page 1

CNET Hardware, CNET.com, Dec 7, 2001, page 1,

http://web.archive.org/web/20011207231045/computers.cnet.com/hardware/resellers/0-

1018-311-6603018.html

MSN Messenger Service, MSN.com, December 7, 2000, page 1,

http://web.archive.org/web/20001207081500/messenger.msn.com/support/news.asp

### (9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

<u>Claims 7, 15, and 20</u>

Claims 7, 15, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by

Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed Jan. 14, 2000).

With regards to claim 7, Graham et al teaches a method comprising:

- *Accepting document information* (column 5, lines 46-48: whereas, any web page

  document that comprises document information, is used as input).

- *Using the document information to determine content in addition to content of the document*: whereas, based on the concepts extracted from the document information, additional content is determined (in this case an ad is the additional content) (column 6, lines 34-39).

- *Using the determined content, determining further content*: whereas, the determined content is the ad that is most relevant (Fig 11A, reference number 1512, column 15, lines 13-19). A second ad (Fig. 11A, reference number 1514) is displayed as further content, and determined by choosing a second ad based on a ranking score, which indicates that it is broader in terms of concept than the first ad (column 15, lines 13-19).

- *Combining at least a portion of content of the document and at least a portion of the determined content, and at least a portion of the determined content, and at least a portion of the determined further content for presentation to a user* (Fig. 11A, column 15, lines 1-23: whereas, the content of the document, the determined content (reference number 1512 is an ad representing the determined content), and the further determined content (reference number 1514) are combined into a browser screen (reference 1503)).

With regards to claim 15, for an apparatus performing a method similar to the method in claim 7, is rejected under the same rationale.

With regards to claim 20, which depends on claim 7, Graham et al teaches *wherein the acts of (b) using the ad document information to determine content in addition to content of the ad document, and (c) combining at least a portion of content of the ad document*

*and at least a portion of the determined content for presentation to the user with page*

*content* (as similarly explained in the rejection for claim 1), are performed automatically

by a machine executing machine-executable instructions is explained in claim 9 of

Graham et al (column 18, lines 41-62), for a computer program comprising executable

instructions, automatically performing the acts of (b) and (c).

Claims 1 and 9 .

Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Graham et al (US Patent: 6, 804,659, published: Oct 12, 2004, filed Jan. 14, 2000).

With regards to claim 1, Graham et al teaches a method comprising:

- *Accepting document information* using web page content, as similarly described
  in claim 7, and is rejected under the same rationale.

- *Using the document information to determine content in addition to content of the*
  *document*, as similarly described in claim 7, and is rejected under the same
  rationale.

- *Using the determined content, determining further content*, as similarly described
  in claim 7, and is rejected under the same rationale.

- *Combining at least a portion of content of the document and at least a portion of*
  *the determined content, and at least a portion of the determined content for*
  *presentation to a user* (as similarly described in claim 7), *together with page*
  *content* (the examiner interprets the limitation "page content" in at least two ways:
  first, page content is interpreted as the output page content generated for display
  and shown in a web browser (as shown in Fig. 11A: whereas the page content of

a browser comprises the document information, as well as the determined

content). Secondly, the page content can be the web page content/document-

information that was used in the 'Accepting document information' step, as

explained earlier, such that the determined ad content is displayed with the web

page content/document-information (Fig. 11A).)

* *Wherein the page content is not directly used to determine the determined*

  *content* (Whereas, the page content, with regards to the first interpretation as

  explained above, is not directly used, since the output page content is generated

  as a result from the determining of determined content, as similarly explained

  above. With regards to the second interpretation of page content, as also

  explained above, the web page/document information is not directly (through the

  definition of directly being: 'without anyone or anything intervening') used to

  determine the determined content, as rather, profile content data is used in

  addition to the web page/document information so as to provide a more

  tailored/fitted version of determined content for display to a user (paragraph

  0005, lines 45-50: whereas profile data is used in addition to the document

  information/web page content)).

However, although Graham et al teaches that the document information accepted is

from a web page, Graham et al does not expressly teach that *the document is at least*

*one ad*. Yet, Graham et al also teaches that the advertisements displayed are web page

content as well (column 4, lines 51-54: whereas, the advertisements are displayed in a

web browser).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Graham et al's system, such that the document information

accepted; would have been a web page comprising an ad as also taught by Graham et

al. The combination would have allowed the client of Graham et al's system to have

obtained additional information based on the ad content retrieved.

With regards to claim 9, for an apparatus performing a similar method to claim 1, is

rejected under the same rationale.

Claims 2, 10, and 17

Claims 2, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed Jan. 14, 2000) in

further view of Bhagavath et al (US Patent: 6,505,169 B1, published: Jan. 7, 2003, filed:

Jan. 26, 2000) and ProductReview (Edmunds.com, Page 1, Jan. 22, 2001).

With regards to claim 2, which depends on claim 1, Graham et al teaches a method

comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.

- *The determined content*, in claim 1, and is rejected under the same rationale.

- An ad database, which stores advertisement meta-data for web advertising

  objects/pages (column 5, lines 17-18: whereas, advertisements are mapped to

  concept related metadata). However, Graham et al does not teach the at least

  one ad *is for a product and wherein* the determined content *is a review for the*

  *product.*

Bhagavath et al teaches ads with associated metadata, which are stored in a cache/database (Fig. 1, reference number 125, column 4, lines 35-40). Furthermore, Bhagavath et al teaches the ad - associated meta data includes display constraints (column 6, 30-34).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham et al's ad-metadata system to have further included display constraints as taught by Bhagavath et al. The combination would have allowed Graham et al's ad selection system to have conditionally displayed ads, not just by concept strength, but also based on additional display constraints.

However, although Graham and Bhagavath et al teach a method for selecting ads based on additional display constraints, they do not expressly teach the at least one ad *is for a product and wherein the determined content is a review for the product.*

ProductReview teaches the *at least one ad is for a product and wherein the determined content is a review for the product* (page 1: whereas, a car is the product, and through inherent display constraints, only additional content concerning a review of the particular car is displayed on the right hand side of the page).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham and Bhagavath et al's display constraints to have further included the constraint to display a review for a product, when a product is being browsed, as taught by ProductReview. The combination of Graham et al, Bhagavath et al, and ProductReview, would have allowed Graham's system to have been able to provide product review information when the ad is a product.

With regards to claim 10, which is dependent on claim 9, for an apparatus performing a similar method to claim 2, is rejected under the same rationale.

With regards to claim 17, which depends on claim 2, Graham et al teaches *wherein the acts of (b) using the ad document information to determine content in addition to content of the ad document, and (c) combining at least a portion of content of the ad document and at least a portion of the determined content for presentation to the user with page content* (as similarly explained in the rejection for claim 1), are performed automatically by a machine executing machine-executable instructions is explained in claim 9 of Graham et al (column 18, lines 41-62), for a computer program comprising executable instructions, automatically performing the acts of (b) and (c).

## Claims 3, 8, 11, 16, and 18

Claims 3, 8, 11, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed: Jan. 14, 2000) in further view of Bhagavath et al (US Patent: 6,505,169 B1, published: Jan. 7, 2003, filed: Jan. 26, 2000) and CNET (CNET.COM, page 1, December 7, 2001).

With regards to claim 3, which depends on claim 1, Graham et al teaches a method comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.

- *The determined content*, in claim 1, and is rejected under the same rationale.

- An ad database, which stores advertisement meta-data for web advertising objects/pages (column 5, lines 17-18: whereas, advertisements are mapped to concept related metadata).

- Furthermore, although Graham and Bhagavath et al teach a method for selecting ads based on additional display constraints, as explained in claim 2, they do not expressly teach the at least one ad *is for a service and wherein* the determined content *is a review for the service.*

CNET teaches at least one ad *is for a service and wherein* the determined content *is a review for the service* (page 1: whereas, 'PC Connection' is the name of the service, and the review is indicated by a "star" ranking system).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham et al and Bhagavath et al's display constraints to have further included the constraint to have displayed a review for a service, when a service was being browsed, as taught by CNET. The combination of Graham et al, Bhagavath et al, and CNET, would have allowed Graham et al's system to have been able to have provided service review information when the ad was a service.

With regards to claim 8, which depends on claim 7, Graham et al, Bhagavath et al, and CNET teach *wherein the determined content is one of a review*, in claim 3, and is rejected under the same rationale.

Furthermore, Graham et al teaches *wherein the further determined content is at least one ad relevant to the determined content*, as explained in claim 7, and is rejected under the same rationale.

With regards to claim 11, which depends on claim 9, for an apparatus performing a method similar to claim 3, is rejected under the same rationale.

With regards to claim 16, which depends on claim 15, for an apparatus performing a similar method to the method in claim 8, is rejected under the same rationale.

With regards to claim 18, which depends on claim 3, Graham et al teaches *wherein the acts of (b) using the ad document information to determine content in addition to content of the ad document, and (c) combining at least a portion of content of the ad document and at least a portion of the determined content for presentation to the user with page content* (as similarly explained in the rejection for claim 1), are performed automatically by a machine executing machine-executable instructions is explained in claim 9 of Graham et al (column 18, lines 41-62), for a computer program comprising executable instructions, automatically performing the acts of (b) and (c).

Claims 4, 12, and 19

Claims 4, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed: Jan. 14, 2000) and Bhagavath et al (US Patent: 6,505,169 B1, published: Jan. 7, 2003, filed: Jan. 26, 2000) in further view of MSN (MSN.COM, page 1, Dec. 7, 2000).

With regards to claim 4, which depends on claim 1, Graham et al teaches a method comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.

- *The determined content*, in claim 1, and is rejected under the same rationale.

- An ad database, which stores advertisement meta-data for web advertising
  objects/pages (column 5, lines 17-18: whereas, advertisements are mapped to
  concept related metadata).

- Furthermore, although Graham and Bhagavath et al teach a method for selecting
  ads based on additional display constraints, as explained in claim 2, they do not
  expressly teach the at least one ad *is for a product or service and wherein* the
  determined content *is a news story about the product or service.*

MSN teaches at least one ad *is for a product or service and wherein* the determined

content *is a news story about the product or service* (MSN, page 1: whereas, MSN

Messenger is the service, and news about MSN Messenger is provided as additional

content).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Graham et al and Bhagavath et al's display constraints to

have further included the constraint to display a news story about a service as taught by

MSN. The combination of Graham et al, Bhagavath et al, and MSN, would have allowed

Graham et al's system to have been able to have provided service news information

when the ad was a service type.

With regards to claim 12, which is depends on claim 9, for an apparatus performing

a method similar to claim 4, is rejected under the same rationale.

With regards to claim 19, which depends on claim 4, Graham et al teaches

*wherein the acts of (b) using the ad document information to determine content in*

*addition to content of the ad document, and (c) combining at least a portion of content of*

*the ad document and at least a portion of the determined content for presentation to the*

*user with page content* (as similarly explained in the rejection for claim 1), are

performed automatically by a machine executing machine-executable instructions is

explained in claim 9 of Graham et al (column 18, lines 41-62), for a computer program

comprising executable instructions, automatically performing the acts of (b) and (c).

Claims 5 and 13

Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed: Jan. 14, 2000) in

further view of Bowman et al (US Patent: 6,006,225, published: Dec. 21, 1999, filed:

Sep. 1, 1998).

With regards to claim 5, which depends on claim 1, Graham et al teaches a

method comprising t*he determined content*, in claim 1, and is rejected under the same

rationale.

However, Graham et al does not teach the determined content *is a search query*

*related to the document.*

Bowman et al teaches the determined content *is a search query related to the*

*document* (column 1, lines 55-67, Fig. 9: whereas, based on the contents of a

document, a suggested query is presented to the user).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Graham et al's system for determining content to have also

included Bowman et al's system for suggesting a query based on document content.

The combination would have allowed Graham et al's system to have been able to

"efficiently locate the most relevant terms" (Bowman et al, column 2, lines 23-24).

With regards to claim 13, for an apparatus performing a similar method as in

claim 5, is rejected under the same rationale.

Claims 6 and 14

Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed: Jan. 14, 2000) in

further view of Weaver (US Application: US 2004/0093558 A1, published: May 13,

2004, filed: Oct. 29, 2003, EEFD: Oct 29, 2002).

With regards to claim 6, which depends on claim 1, Graham et al teaches a

method comprising *the determined content*, in claim 1, and is rejected under the same

rationale. Furthermore, Graham et al teaches determining the content by going through

an advertisement database for related concepts, as explained in claim 1. However,

Graham et al does not teach the determined content *is a message from a user group.*

Weaver teaches a message database that stores *messages from a user group*

(claim 2).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Graham et al's advertisement database, which associated

advertisements with concepts; to a database that stored messages (as taught by

Weaver) which associated messages with concepts.  The combination would have

allowed Graham et al's system to have been able to determine the most appropriate

user group message based on the document content.

With regards to claim 14, which depends on claim 9, for an apparatus performing a similar method to claim 6, is rejected under the same rationale.

### (10) Response to Argument

Claims 7, 15, and 20

The appellant first argues that the Graham patent does not teach "using document information to determine additional content, using the additional content to determine further content", since the cited portions of Graham patent in the office action "merely show using document content to determine additional content -- both ads 1512, and 1514 – both ads 1512 and 154. They do *not* show using the additional content (e.g. ads 1512 and 1514) to determine further content, and combining at least portions of the document, the determined additional content (e.g. ads 1512 and 1514), and the determined further content for presentation to a user". The appellant proceeds to cite the following arguments made by the examiner:

- "the *content of* a first ad (1512) is selected based upon a relevancy score, such that the score is based upon the relevancy of content of the input document, with respect to user interests, and advertisement concepts"

- "Thus, when the content of the second ad (1514) is selected to be broader aspect/relevancy than the first advertisements (for which relevancy is based upon the relevancy is based upon the relevancy of the *content*, as explained previously), then the selection based upon known relevancy of the first ad, is also based upon the content of the first ad, and thus, the applicant's argument for

Graham not teaching *using additional content to determine further content,* is not

persuasive.

The appellant then proceeds to attack the above cited arguments that were made by the

examiner by citing a passage from the Graham patent:

- "... In this particular example, both advertising display areas 1512 and 1514

    display advertisements about a related concept, wearable computers. It is

    noteworthy that the advertisement displayed in area 1514 is directed to a

    broader aspect of the underlying concept of wearable computers than the

    advertisement displayed in area 1512. These advertisements have been

    selected using the relevancy techniques described herein ...".

- Advertisements can be retrieved "based upon a determined relevancy between

    the user's interests, ... the advertiser's concepts and the content of the current

    document being viewed"

The appellant argues that the above passage cited from Graham *"in no way teaches*

*(nor does it suggest) somehow determining the second ad in area 1514 (alleged to be*

*claimed "further content") using the first ad in area 1512 (alleged to be the claimed*

*"additional content"). Nowhere does the Graham patent teach, either explicitly or*

*inherently, that a second ad is determined using a first ad, which was determined using*

*content information, all of which are displayed to the user. Furthermore, merely noting*

*that a second ad (selected using relevancy to a document) is directed to a broader*

*aspect than a first ad (which was also selected using relevancy to the document), does*

*not support the conclusion that the second ad is determined using the first ad.* The

appellant further supports this argument by providing an example:

> In EXAMPLE A, two advertisements are determined from
> the statement, "Dogs are popular pets."
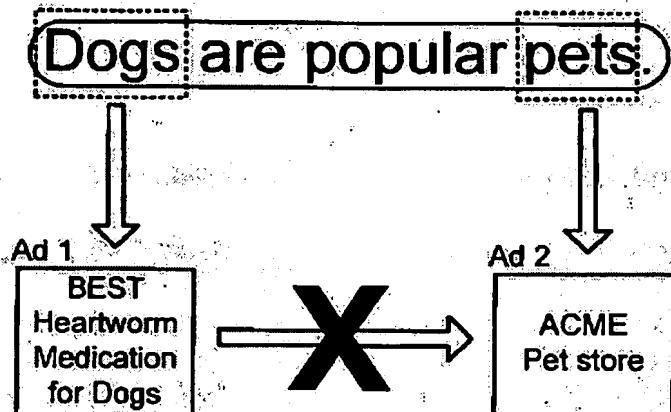


EXAMPLE A

> Specifically, Ad 1 was determined using the word "Dogs"
> and is for a brand of heartworm medication for dogs. Ad
> 2 was determined using the word "pets" and is for a
> particular pet store. Ad 1 is directed to a more
> specific concept than Ad 2. Both ads were determined
> from different parts of the same source. Although Ad 2
> is directed to a broader concept than Ad 1, note that it
> was not *determined using* Ad 1.

The examiner respectfully points out that the appellant's argument is not analogous to

the Graham patent, since the examiner agrees that Ad2 does not refer to content of

Ad1. In other words, Ad 2 does not need any information from Ad 1 to display the

content 'ACME Pet Store'. Yet, with respect to the Graham patent, the "further content"

(Ad 1514) is broader than the "additional content" 1512 (Column 15, lines 1-23). Thus,

although the examiner agrees that not *all the content* that is determined from 1512 is

used; at least some information from the first additional content 1512, is

used/referenced to create a second Ad 1514, such that it is *broader* than the further

content (the information used/determined, being the scope of the concept data used in

the "additional content" 1512). Thus, the appellant's argument is not persuasive.

The appellant also uses a second example to support the appellant's argument, by

using a Grandparent/father/uncle/child hierarchical tree:

In EXAMPLE B, a child's relationships are shown.
The child's Uncle is the child of the child's
Grandparents.
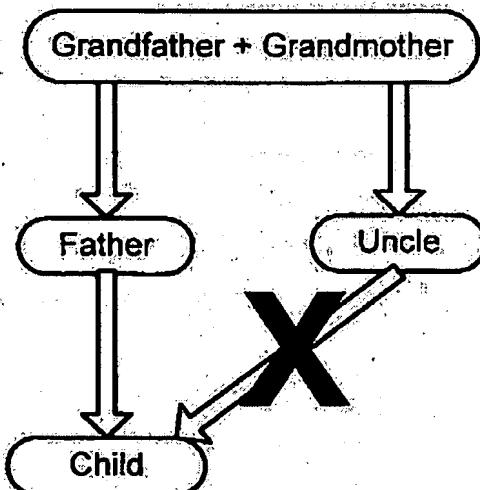


*EXAMPLE B*

The genes of both the child and the Uncle were
"determined from" (as least in part in the case of the
child) the genes of the Grandparents. The Uncle is
genetically closer to the Grandparents than the Child.
However, the relative characteristic (i.e., genetic
similarity to the grandparents) between the Uncle and the
Child does not support the conclusion that the Child's
genes were "determined using" the genes of the Uncle.

However, the appellant's second example is also not persuasive, since it is not

analogous to the Graham patent, as for the same reasons example 'A' is not analogous

(the Graham patent actually uses content data from the additional content, to generate

further data that is broader in concept, then the content/concept used in the additional

content.)

Based upon the above arguments made by the appellant, the appellant thus argues that

claims 7 and 15 are not anticipated by the Graham patent. However, this argument is

not persuasive since the limitations argued by the appellant, have been shown to been

taught, as similarly explained above.

Claims 1 and 9

With regards to claims 1 and 9, the appellant argues that the Graham patent neither

teaches, nor suggests, *"using information of at least one ad to determine information in*

*addition to the at least one ad, and combining at least a portion of the at least one ad*

*and the additional information for presentation to a user together with page content,*

*wherein the page content is no directly used to determine content"*. Listed below, are

arguments made by the appellant, as to why *"the determined ads are not used to*

*determine information in addition to the ads"* , and also explanations (made by the

Examiner) for why each of the arguments are not persuasive.

- Argument #1: The cited portion (made by the examiner, with respect to column 4, lines 51-54 of the Graham patent), *merely notes that ads can be displayed in a user's browser.* As shown in Figure 11A, the ads 1512 and 1514 are provided in a portion of the browser screen 1503 separate from the document. This might be to avoid "reformatting the web page (column 1, lines 42-45), and thus [the advertisements are not Web page content.

  o Response by Examiner #1: However, the examiner respectfully points out in column 4, lines 50-55: "Web advertisement objects likely to appeal to a particular user can be displayed in marketing information area of the user's browser. Thus, the marketing information area displays web content (Web advertisement objects). Furthermore, the web browser displays the marketing information area, and the marketing information area contains 1512, and 1514, as similarly explained in column 15, lines 1-20. Thus, since the marketing information area includes 1512, and 1514, and the marketing information area displays web content in a Web browser, the appellant's argument is not persuasive.

- Argument #2: "Even, if the web page includes embedded advertisements, claims 1 and 9 recite combining at least a portion of the at least one ad and the additional information for presentation to a user *together with page content, wherein the page content is not directly used to determine the determined content.* That is, under the Examiner's proposed combination, the additional content would be *determined using the page content* (i.e., ads embedded on the

page) directly, whereas the claim requires that this cannot be the case. Yet,

there the examiner does not provide convincing arguments as to why the "page

content" is *not directly used to determine the determined content* [and] *these*

*arguments are directed to the Graham patent before it is modified as* proposed

by the Examiner. That is, when the Graham patent is modified by the Examiner

to address the fact that the ad document information is used to determine

additional content, the Examiner's arguments about interpretations of the "page

content' without the proposed modification are no longer valid.

- o Response by Examiner #2: As cited from the previous final office action,

  "the page content is not directly used to determine the determined content

  … since the web page/document information is not directly (through the

  definition of directly being: 'without anyone or anything intervening') used

  to determine the determined content, as rather, profile content data is

  used in addition to the web page/document information so as to provide a

  more tailored/fitted version of determined content for display to a user

  (paragraph 0005, lines 45-50: whereas profile data is used in addition to

  the document information/web page content))". The Graham patent is

  then modified, such that the document information (which is not directly

  used due to profile information, as explained above), can be at least one

  ad, and therefore producing a combination that the at least one ad

  document, is not directly used since profile information is used. Thus, the

appellant's argument is not persuasive, since the combination does teach

that the proposed modification is valid.

- Argument #3: "if the page content is the output page content generated for

  display and shown in a web browser (examiner's first interpretation), such

  content is not *combined with* at least a portion of the ad document and at least a

  portion of the determined content as claimed. That is, the Examiner's first

  interpretation of "page content" is the final output presented to the user, and is

  therefore not combined with anything.

  - o  Response by Examiner #3: However, the Examiner respectfully clarifies

    the interpretation of the claim language. With respect to the claim

    language, the Examiner interprets the claim language: *combining at least*

    *a portion of content of the document and at least a portion of the*

    *determined content, and at least a portion of the determined content for*

    *presentation to a user, together with page content*, to also mean

    *combining at least a portion of content of the document and at least a*

    *portion of the determined content, and at least a portion of the determined*

    *content for presentation to a user, together* [and the portions are

    combined] *with*/through-the-use of output *page content*. Thus, the

    appellant's argument is not persuasive since the portions have all been

    combined, to produce output *page content* (the combination steps being

    performed to generate the page content.

- Argument #4: If on the other hand, the page content is the accepted (ad ) document information (the examiner's second interpretation), such content is directly used to determine content combined with the page. The Examiner is inappropriately equating "directly" with "solely" or "exclusively" This is unlike the case where the page content is not directly used to determine content (which was determined using ad document information) as claimed

  o Response by Examiner #4: Since the claim language does not specify the particular aspect to the limitation "not directly", the examiner interprets the limitation "not directly" to be "without anything intervening". The page content is not directly used to determine the determined content ... since the web page/document information is not directly (through the definition of directly being: 'without anyone or anything intervening') used to determine the determined content, as rather, profile content data (intervening data) is used in addition to the web page/document information so as to provide a more tailored/fitted version of determined content for display to a user (paragraph 0005, lines 45-50: whereas profile data is used in addition to the document information/web page content)). Thus, the appellant's argument is not persuasive.

With regards to appellant's argument that claims 1 and 9 being rendered not obvious by the Graham patent for at least the foregoing reasons, is not persuasive since claims 1 and 9 have been shown/explained to be rejected.

Claims 2 and 10

With regards to claims 1 and 9, the appellant argues that the proposed combination

would not compensate for the deficiencies of the Graham patent with respect to claims

1 and 9, discussed above. However, the appellant's argument is not persuasive, as

explained in the arguments above. Furthermore, the appellant argues that claims 2 and

10, which depend on claims 1 and 9, are allowable for at least the first reason. Yet,

claims 1 and 9 have been explained to been rejected, and thus, the appellant's

argument is not persuasive.

The appellant argues that in the Edmunds reference, the product review is apparently

jus a portion of an authored article. That is, based merely on the page printout, the

Appellant believes that the photo caption is not determined using ad information, but is

simply part of an authored article. Listed below, are arguments made by the appellant,

as to why "*the photo caption is not determined using ad information*" , and also

explanations (made by the Examiner) for why each of the arguments are not

persuasive.

- Argument #1: a "capability to do something is not a teaching or suggestion to

    actually do it. The Bhagavath patent is merely cited as teaching using audience

    demographics, time and date to constrain the serving of ads inserted into

    streaming media. This in no way determines content based on an ad, but rather

    is used to help determine whether or not to display the ad.

    - Response by Examiner #1: However, Graham already teaches

        *determining content based on an ad* (the ad containing web data, as well

as the determined content containing web data), as similarly explained in the final office action with respect to the rejection for claim 1, and also explained above in the response to arguments. Thus, the logic/teaching of Graham to determine content based on an ad was explained: "such that the document information accepted; would have been a web page comprising an ad", explained in the page 5 of the final office action, Additionally, the examiner agrees that the Bhagavath patent is used to determine whether or not to display an ad, however, it is the ProductReview/Edmunds reference, which shows that the determined web content can be web data of a product-review, and the ad is web data of a product (page 1: whereas, a car is the product, and additional content is displayed on the right hand side of the page). Thus, the appellant's argument is not persuasive since data associated with an ad (such as a web product review of a product ad) is determined and displayed, as suggested by the combination of Graham, Bhagavath, and ProductReview/Edmunds.

- Argument #2: Since the cited art does not suggest the combination proposed by the Examiner, the proposed combination is apparently the product of impermissible hindsight. The examiner merely concludes that the combination would have allowed Graham's system to have been able to provide product review information when the ad is a product. Where, if not from the applicant's own disclosure, was this solution gleaned. If anything, the Graham patent might

determine ads related to a product review, but, as established above, determines

nothing from ads, let alone product reviews.

- o Response by Examiner #2: The rejection of claim 1, in page 5 of the final

  office action explains that the Graham teaches determining (web) content

  based on an ad (web data). It has already been shown/explained that the

  combination of Graham and Bagavath include the capability (and teach) to

  *display the determined content* (using display constraints), *based upon the*

  *at least one ad*, and thus, the ProductReview/Edmunds reference is

  merely used to include the prior teachings that the *determined content*

  *(using display constraints) is a review*, and also to show the prior

  teachings of the *document information being an ad*. Thus, the final

  combination (Graham, Bagavath, and ProductReview/Edmunds),

  produces the necessary elements to show the applicant's argument is not

  persuasive, and also to have provide test reports/reviews, such as Vehicle

  test reports (page 1 of ProductReview/Edmunds).

## Claim 17

The applicant argues that claim 17 is not rendered obvious by the cited patents for at

least the reasons discussed above with reference to claim 2. However, claim 2 has

been shown/explained to be rejected, and thus, the argument is not persuasive.

The applicant also argues that claim 17 "further recites that certain acts are

performed automatically by a machine executing machine-executable instructions.

Although the Graham patent can be provided as a computer executing program

instructions, the content of the Edmunds page is manually authored, not

automatically generated". However, this argument is not persuasive, since the

functionality for determining content based on an ad (taught by Graham), is applied

to the properties of the Edmunds teachings, such that the content is automatically

generated.

Claims 3 and 11

With regards to claims 3 and 11, the applicant argues that the proposed combination

would not compensate for the deficiencies of the Graham patent with respect to claims

1 and 9, and thus not rendered obvious. However, this argument is not persuasive since

claims 1 and 9 have been shown/explained to be rejected.

The appellant argues that in the CNET page, that based merely on the page printout,

the Appellant believes that the service review is not determined using Ad Information.

Listed below, are arguments made by the appellant, and also explanations (made by

the Examiner) for why each of the arguments are not persuasive.

- Argument #1: a "capability to do something is not a teaching or suggestion to

  actually do it. The Bhagavath patent is merely cited as teaching using audience

  demographics, time and date to constrain the serving of ads inserted into

  streaming media. This in no way determines content based on an ad, but rather

  is used to help determine whether or not to display the ad.

  - o  Response by Examiner #1: However, Graham already teaches

    *determining content based on an ad* (the ad containing web data, as well

    as the determined content containing web data), as similarly explained in

the final office action with respect to the rejection for claim 1, and also

explained above in the response to arguments. Thus, the logic/teaching of

Graham to determine content based on an ad was explained: "such that

the document information accepted; would have been a web page

comprising an ad", explained in the page 5 of the final office action,

Additionally, the examiner agrees that the Bhagavath patent is used to

determine whether or not to display an ad, however, it is the CNET

reference, which shows that the determined web content can be a review

for the service, and the ad is for a service (page 1 of CNET: whereas,, 'PC

Connection' is the name of the service, and the review is indicated by a

"Star" ranking system). Thus, the appellant's argument is not persuasive

since data associated with an ad (such as a review of a service) is

determined and displayed, as suggested by the combination of Graham,

Bhagavath, and CNET.

- Argument #2: Since the cited art does not suggest the combination proposed by

  the Examiner, the proposed combination is apparently the product of

  impermissible hindsight. The examiner merely concludes that the combination

  would have allowed Graham's system to have been able to provide a review for a

  service when the ad is a service. Where if not from the applicants' own

  disclosure, was this solution gleaned. If anything, the Graham patent might

  determine ads related to a service, but, as established above, determines

  nothing from ads, let alone service reviews.

    o  The rejection of claim 1, in page 5 of the final office action explains that the Graham teaches determining (web) content based on an ad (web data). It has already been shown/explained that the combination of Graham and Bagavath include the capability (and teach) to *display the determined content* (using display constraints), *based upon the at least one ad*, and thus, the CNET reference is merely used to include the prior teachings that the *determined content (*using *display constraints) is a review for the service*, and also to show the prior teachings of the *document information being an ad*. Thus, the final combination (Graham, Bhagavath, and CNET), produces the necessary elements to show the appellant's argument is not persuasive.

## Claim 18

The appellant argues that claim 18 depends from claim 3, and thus, would not be rendered obvious by the cited patent. However, this argument is not persuasive since claim 3 has been shown/explained to be rejected.

The appellant also argues that certain acts are performed automatically by a machine executing machine-executable instructions. Although the Graham patent can be provided as a computer executing program instructions, the content of the CNET page is manually authored, not automatically generated. However, this argument is not persuasive the functionality for determining content based on an ad (taught by Graham),

is applied to the properties of the CNET teachings, such that the content is

automatically generated.


Claims 8 and 16

The appellant first argues that since claims 8 and 16 depend from claims 7 and 15, they

are rendered not obvious. However, claims 7 and 15 have been explained/shown to be

rejected, and thus, the argument is not persuasive.


- Argument #2: a "capability to do something is not a teaching or suggestion to

  actually do it. The Bhagavath patent is merely cited as teaching using audience

  demographics, time and date to constrain the serving of ads inserted into

  streaming media. This in no way determines content based on an ad, but rather

  is used to help determine whether or not to display the ad.

  - o Response by Examiner #1: However, Graham already teaches

    *determining content based on an ad* (the ad containing web data, as well

    as the determined content containing web data), as similarly explained in

    the final office action with respect to the rejection for claim 1, and also

    explained above in the response to arguments. Thus, the logic/teaching of

    Graham to determine content based on an ad was explained: "such that

    the document information accepted; would have been a web page

    comprising an ad", explained in the page 5 of the final office action,

    Additionally, the examiner agrees that the Bhagavath patent is used to

determine whether or not to display an ad, however, it is the CNET

reference, which shows that the determined web content is web data of a

review). Thus, the appellant's argument is not persuasive

- Argument #3: the service review is not *further information determined from additional content which was determined from document content.*

    o Response by Examiner #2: However, the claim language does not require that the service *review to be further information determined from additional content which was determined from document content.* Instead in the as stated in the claim language <u>*the determined content is one of a review.*</u> Also in the claim language, "<u>the further determined content</u>" refers to the further determined content limitation in claim 7, not elsewhere in claim 8 (in other words, the 'further determined content' does not reference the service review mentioned earlier in claim 8, since the service review is 'determined content', not 'further determined content'). Thus, the appellant's argument is not persuasive.

- Argument #4: Since the cited art does not suggest the combination proposed by the Examiner, the proposed combination is apparently the product of impermissible hindsight. The examiner merely concludes that the combination would have allowed Graham's system to have been able to provide a review for a service when the ad is a service. Where if not from the applicants' own disclosure, was this solution gleaned? If anything, the Graham patent might

determine ads related to a service review, but, as established above, determines

nothing from ads, let alone service reviews.

    o  The rejection of claim 1, in page 5 of the final office action explains that

        the Graham teaches determining (web) content based on an ad (web

        data). It has already been shown/explained that the combination of

        Graham and Bagavath include the capability (and teach) to *display the*

        *determined content* (using display constraints)*, based upon the at least*

        *one ad*, and thus, the CNET reference is merely used to include the prior

        teachings that the *determined content (*using *display constraints) is a*

        *review for the service.* Thus, the final combination (Graham, Bhagavath,

        and CNET), produces the necessary elements to show the appellant's

        argument is not persuasive.

Claims 4 and 12

The appellant first argues that the proposed combination would not compensate for the

deficiencies of the Graham patent with respect to claims 1 and 9 discussed above, and

thus, claims 4 and 12 are not rendered obvious by the cited references for at least this

first reason. However, this argument is not persuasive since claims 1 and 9 have been

shown/explained to be rejected.

    •  Argument #2: The news is apparently just a portion of an authored document.

        That is, based merely on the page printout, the "Appellant believes that the news

        about MSN messenger was not determined using ad information", but is simply

        part of an authored article.  First, a "capability " to do something is not a teaching

or suggestion to actually do it. The Bhagavath patent is merely cited as teaching using audience demographics, time and date to constrain the serving of ads inserted into streaming media. This in no way determines content based on an ad, but rather is used to help determine whether or not to display the ad. Thus, claims 4 and 12 are not rendered obvious by the Graham and Bhagavath patents and the CNET page for at least this second reason.

   o Examiner response #2: However, Graham already teaches *determining content based on an ad* (the ad containing web data, as well as the determined content containing web data), as similarly explained in the final office action with respect to the rejection for claim 1, and also explained above in the response to arguments. Thus, the logic/teaching of Graham to determine content based on an ad was explained: "such that the document information accepted; would have been a web page comprising an ad", explained in the page 5 of the final office action, Additionally, the examiner agrees that the Bhagavath patent is used to determine whether or not to display an ad, however, it is the MSN reference which teaches the ad (containing web data) is *for a product or a service and wherein* the determined (web data) content *is a news story about the product or service*. Thus, the appellant's argument is not persuasive since data associated with an ad (such as a news story of a product ad) is determined and displayed, as suggested by the combination of Graham, Bhagavath, and MSN.

- Argument #3: the Examiner merely concludes that the combination would have allowed Graham's system tohave been able to provide a news story about a service when the ad is a service type. Where, if not from the applicatns' own disclosure was this solution gleaned? If anything, the Graham paten tmight determine ads related to a service review, but, as established above, determines nothing from ads, let alone service reviews. Thus, claims 4 and 12 are not rendered obvious for this reason.

  o Examiner response: #3 The rejection of claim 1, in page 5 of the final office action explains that the Graham teaches determining (web) content based on an ad (web data). It has already been shown/explained that the combination of Graham and Bagavath include the capability (and teach) to *display the determined content* (using display constraints), *based upon the at least one ad*, and thus, the MSN reference is merely used to include the prior teachings that the *determined content (*using *display constraints) is for a news story for the service*, and also to show the prior teachings of the *ad* is *for a service*. Thus, the final combination (Graham, Bhagavath, and MSN), produces the necessary elements to show the appellant's argument is not persuasive.

## Claim 19

The appellant argues that since claim 19 depends on claim 4, it is not rendered obvious by the cited patents for at least the reasons discussed above with reference to claim 4.

However, this argument is not persuasive since claim 4 has been shown/explained to
be rejected, as discussed above.

The appellant also argues that certain acts are performed automatically by a machine
executing machine-executable instructions. Although the Graham patent can be
provided as a computer executing program instructions, the content of the MSN page is
manually authored, not automatically generated. However, this argument is not
persuasive, since the functionality for determining content based on an ad (taught by
Graham), is applied to the properties of the MSN teachings, such that the content is
automatically generated.

Claims 5 and 13

The appellant first argues that the search query information is not *generated from
ad document information as claimed*.  However, in response to applicant's arguments
against the references individually, one cannot show nonobviousness by attacking
references individually where the rejections are based on combinations of references.
See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800
F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As explained in page 12 of the final office
action, Bowman is explained to teach a search query related to the document (column
1, lines 55-67, Fig. 9: whereas, based on the contents of a document , a suggested
query is presented to the user). Bowman is then combined with Graham; for which
Graham teaches *the determined content, and* which the determined content is
*generated from ad document information* (as explained in page 5 and 6 of the final
office action:  whereas, the combination of Graham is taught to determine content from

ad document information). Thus, Bowman teaches generating a search query related to a particular document, and Graham teaches the determined content generated from the particular document, the combination would produce a method to use an ad document as the query correlation data file. Thus, the appellant's argument is not persuasive.

- Appellant argument #2: Since claims 5 and 13 depend from claims 1 and 9, respectively, they are not rendered unpatentable by the cited references for at least the same reasons as discussed above with reference to claims 1 and 9, and thus, claims 5 and 13 are not rendered obvious by the Graham and Bowman patents for at least this additional reason.

  o Examiner response #2: However, this argument is not persuasive since claims 1 and 9 have been shown/explained to be rejected, as similarly explained in the previous office action, and in the response to arguments above.

- Appellant argument #3: The Examiner merely concludes that the combination would have allowed Graham's system to efficiently locate the most relevant terms. However, the Graham patent is concerned with serving relevant advertisements, not helping a user to formulate a search query for a search engine. Helping a user to formulate a search query would not help the functionality related to finding a relevant ad discussed in the Graham patent. Thus, one skilled in the art would not have been motivated to modify the Graham patent as proposed by the Examiner.

o In response to applicant's argument that there is no suggestion to combine

the references, the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to

produce the claimed invention where there is some teaching, suggestion,

or motivation to do so found either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. See *In re*

*Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*,

958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Graham

teaches locating and determining information, such as by using user's

concepts of interests, advertiser's concepts, and a currently viewed

document (Graham, Abstract), and thus information is retrieved to

accommodate and select data of best/relevant interest. Bowman also

teaches selecting data of best/relevant interest to "efficiently locate the

most relevant terms" (Bowman, column 2, lines 23-24). Thus, both are in

the same data retrieval arts, and one would have been motivated to

further tailor data retrieval, by using Bowman to retrieve relevant terms;

and therefore, the appellant's argument is not persuasive.

Claims 6 and 14

• Appellant Argument #1: The Weaver publication concerns copying messages

from a first forum to a new forum. The message is not generated using ad

document information as claimed.

- o Examiner Response #1: : However, Graham already teaches *determining content based on an ad* (the ad containing web data, as well as the determined content containing web data), as similarly explained in the final office action with respect to the rejection for claim 1, and also explained above in the response to arguments. Thus, the logic/teaching of Graham to determine content based on an ad was explained: "such that the document information accepted; would have been a web page comprising an ad", explained in the page 5 of the final office action. Thus the Weaver publication is used to show that the determined content can also be a message from a user group (page 13 of Final Office Action), and the overall combination teaches the message generated using ad document information (as similarly explained in page 13 of the Final Office action). Thus, the appellant's argument is not persuasive.

- Appellant Argument #2: since claims 6 and 14 depend from claims 1 and 9, respectively, they are not rendered unpatentable by the cited references for at least the same reasons as discussed above with reference to claims 1 and 9, and thus, claims 6 an 14 are not rendered obvious by the Graham patent and Weaver publication.

  - o Examiner response #2: This argument is not persuasive since claims 1 and 9 have been shown/explained to be rejected as explained in the previous office action, and also as explained in the response to arguments above.

- Appellant argument #3: However, the Examiner merely concludes that the combination would have allowed Graham's system to have messages associated with concepts rather than have ads associated with concepts. However, the purpose of the Graham patent is to serve relevant advertisements, not somehow finding user group messages relevant to a document and a user viewing the document.

Examiner response #3: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.  See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).  In this case, Graham teaches locating and determining information, such as by using user's concepts of interests, advertiser's concepts, and a currently viewed document (Graham, Abstract), and thus information is retrieved to accommodate and select data of best/relevant interest. Weaver also teaches retrieval of information from a database based on user interests/requests (Claim 1 of Weaver). Thus, both Graham and Weaver are in the data retrieval arts, and one of the ordinary skill in the art would have modified Graham's retrieval system, such that messages are available for retrieval upon user interests/request; and therefore, the appellant's argument is not persuasive.

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

### (11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

*W. T. 11/21/07*

Wilson Tsui

Patent Examiner

Art Unit: 2178

November 21, 2007

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Conferees:
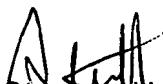
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